



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

29

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/367,013	08/05/1999	DEBORAH KNUTZON	86014/8145	3773

22242 7590 07/18/2006

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

NASHED, NASHAAT T

ART UNIT PAPER NUMBER

1656

DATE MAILED: 07/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/367,013	KNUTZON ET AL.	
	Examiner	Art Unit	
	Nashaat T. Nashed, Ph. D.	1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 215-244, 255-274 and 298-373 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 215-224, 255-264, 325, 328, 338, 341, 351, 354, 364 and 367 is/are allowed.
- 6) ☒ Claim(s) See Continuation Sheet is/are rejected.
- 7) ☒ Claim(s) 323, 324, 336, 337, 349, 350, 362, 363, and 373 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims rejected are 225-244,265-274,298-322,326,327,329-335,339,340,342-348,352,353,356-361,365,366 and 368-372.

Art Unit: 1656

The application has been amended as requested in the communication filed May 19, 2006.

Claims 186-198, 200-217, 219-235 and 241-243 are under consideration.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 235-244, 327, 340, 353, and 366 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the prior Office action mailed November 14, 2005.

In response to the above rejection, applicants argue that the claims meet the written description requirement as the specification teach the nucleic and amino acid sequences of SEQ ID NO: 1 and 2, and their function. In addition, they argue that one of ordinary skill in the art would know how to obtain the various deletion that have the specific function in the claim.

Applicants arguments filed 5/19/06 have been fully considered, but they are found unpersuasive. While applicants are correct about the teaching of the specification, the application fail to teach the various structural element of the protein, which may include the active site residues of the desaturase, the amino acid residues which are responsible for the substrate and regioselectivity of the enzyme. The specification provided no guidance to one of ordinary skill in the art, which amino acid residues can be deleted without loss of enzymatic activity, regioselectivity of the reaction that it catalyzes, and substrate specificity. Thus, the claims remain rejected.

Claims 298, 299, 301-309, 330, 343, 356, and 369 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the prior Office action mailed November 14, 2005.

Applicant repeated their previous argument regarding the hybridization language.

Applicants arguments filed 5/19/06 have been fully considered, but they remain unpersuasive. Applicants must remove the new matter from the claims. The claim does not have support in the specification.

Art Unit: 1656

Claims 300, 310-318, 331, 344, 357, and 370 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention for the reasons set forth in the prior Office action mailed November 14, 2005.

In response to the above rejection, applicants argue that claim 244 invokes 35 USC 112, paragraph six.

Applicants arguments filed 5/19/06 have been fully considered, but they are found unpersuasive. MPEP 2181 (II) teaches that the mean plus function claims must satisfy the written description requirement. The previous Office action has set forth a case of lack of written description, and identified the shortcoming of specification in describing the claimed invention consistent with the court direction. The court of Appeals for the Federal Circuit has held that a "written description of an invention involving a chemical genus, like a description of a chemical species, 'requires a precise definition, such as by structure, formula [or] name chemical name,' of the claimed subject matter sufficient to distinguish it from other materials." *UC California v. Eli Lilly* (43 USPQ2d 1398). For claims drawn to genus, MPEP section 2163 states the written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., structure or physical and/or chemical properties, by functional characteristics coupled with known or disclosed correlation between function and structure, or by a combination of such identifying characteristics, sufficient to show the applicant was in possession of the claimed genus. Also, MPEP section 2163 states that a representative number of species mean that the species, which are adequately described, are representative of the entire genus. Thus, when there is substantial variation within the genus, one must describe a sufficient variety of species to reflect the variation within the genus.

Claims 225-234, 265-274, 319-322, 326, 329, 332-335, 339, 342, 345-348, 352, 355, 358-361, 365, 368, 371, and 372 are rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the prior Office actions including the last Office action mailed November 14, 2005.

Applicants have reiterated their previous argument without any supporting evidence and amend the claims to expand their scope.

Applicants arguments filed 5/19/06 have been fully considered, but they remain unpersuasive. Applicants' arguments for lack enablement have been addressed repeatedly in several Office actions. Applicants are advised to review the Office action mailed November 14, 2005. The claims remain rejected for reasons of records.

Art Unit: 1656

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claims 298, 299, 301-309, 330, 343, 356, and 369 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following are the reasons for the rejections for the reasons set forth in the prior Office action mailed November 14, 2005.

Applicants have not responded to the above rejection.

Claims 323, 324, 336, 337, 349, 350, 362, 363, and 373 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Claims 215-224, 255-264, 325, 328, 338, 341, 351, 354, 364, and 367 are allowed.

No claim is allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

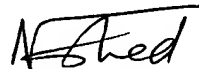
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nashaat T. Nashed, Ph. D. whose telephone number is 571-272-0934. The examiner can normally be reached on MTWTF.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathleen Kerr, Ph. D. can be reached on 571-272-0931. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1656

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Nashaat T. Nashed, Ph. D.
Primary Examiner
Art Unit 1652